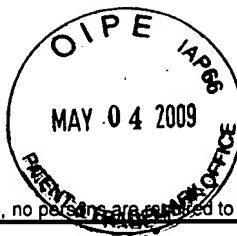


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08049.0765-00000

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on _____

Signature _____

Typed or printed name _____

Application Number

09/839,241

Filed

April 23, 2001

First Named Inventor

Robert KRAUSE

Art Unit

3621

Examiner

Pierre E. ELISCA

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

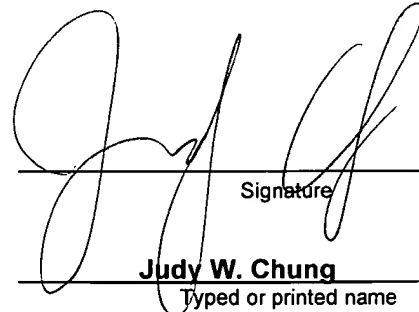
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.

Registration number **61,612**

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


Signature
Judy W. Chung
Typed or printed name

(571) 203-2700

Telephone number

May 4, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Customer No.: 22,852
Attorney Docket No. 08049.0765-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Robert KRAUSE et al.)	Group Art Unit: 3621
)	
Serial No.: 09/839,241)	Examiner: ELISCA, Pierre E.
)	
Filed: April 23, 2001)	
)	
For: SYSTEMS AND METHODS FOR)	Confirmation No.: 4011
PROVIDING CHANGE OF ADDRESS)	
SERVICES OVER A NETWORK)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, completed form PTO/SB/33, petition for a three-month extension of time, appeal fee payment, and extension of time fee payment filed concurrently herewith, Applicants respectfully request a pre-appeal brief review of this application.

I. The Examiner Did Not Establish that *Tsuei* Discloses Each and Every Element of Applicants' Claims Either Expressly or Inherently

To establish that *Tsuei* anticipates Applicants' claims under 35 U.S.C. § 102(e), the Examiner must show that *Tsuei* discloses each and every element of Applicants' claims, either expressly or inherently. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Furthermore, the identical disclosure "must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The Examiner

has clearly erred in his interpretation of the teachings of the prior art because *Tsuei* fails to disclose each and every element of each claim. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 102(e) be withdrawn.

For example, independent claim 4 recites, *inter alia*, "creating a second change of address record at [a] service center by modifying [a] first change of address record received from [a] change of address server," "forwarding the second change of address record electronically from the service center to a forwarding service unit corresponding to [an] old address of [a] customer," and "processing, by the forwarding service unit, the second change of address record received from the service center electronically to automatically redirect mail addressed to the old address of the customer to [a] new address of the customer." As explained on page 4 of the Reply filed October 24, 2007, and on page 3 of the Reply filed July 10, 2008, *Tsuei* fails to teach or suggest at least these elements of claim 4.

In the Final Office Action ("FOA"), mailed November 5, 2008, the Examiner characterized the system in *Tsuei* and alleged that "*Tsuei* discloses a first and a second change of addresses for accessing a database, and therefore is equivalent to Applicant's claimed invention." (FOA, p. 5, lines 8-10). However, as explained on page 4 of the Reply filed October 24, 2007, and on page 3 of the Reply filed July 10, 2008, *Tsuei* fails to teach or suggest at least the second change of address record having the characteristics recited in claim 4. The Examiner broadly characterized the *Tsuei* system as a computer system that manages a database of stored records correlating a first email address, e.g., an old e-mail address, and a second email address, e.g., a new e-mail address. (FOA, p. 4, line 19 - p.5, line 3). But, the Examiner ignores several

features recited in claim 4 in asserting the *Tsuei* change of e-mail addresses are equivalent to the change of mailing address records as claimed.

While *Tsuei* discloses an e-mail address management system ("EAMS") correlating old e-mail addresses with new e-mail addresses, *Tsuei* fails to disclose a first change of address record and a second change of address record. As taught by *Tsuei*, "the preferred EAMS . . . contains an old address and a new address for each address change registered with the EAMS . . . and stored in the database Preferably, this address change information is stored in the form of a data record . . . including an old e-mail address field . . . and a new e-mail address field" (col. 6, lines 35-41). Therefore, contrary to the Examiner's characterization of *Tsuei*, *Tsuei* expressly teaches that a single change of address record is created to correlate the old e-mail address with the new e-mail address. There is no disclosure of a second change of address record in *Tsuei*. Because *Tsuei* fails to disclose "a second change of address record," *Tsuei* necessarily fails to disclose at least "creating a second change of address record at [a] service center by modifying [a] first change of address record received from [a] change of address server," "forwarding the second change of address record electronically from the service center to a forwarding service unit corresponding to [an] old address of [a] customer," and "processing, by the forwarding service unit, the second change of address record received from the service center electronically to automatically redirect mail addressed to the old address of the customer to [a] new address of the customer," as recited in independent claim 4.

For at least the foregoing reasons, *Tsuei* does not disclose or teach each and every claim element recited in independent claim 4, and independent claims 6, 8, 14,

55, 63, 66, 68, 74, 115, 126, 128, 130, 136, and 177, which contain features similar to those recited in independent claim 4. Similarly, dependent claims 5, 7, 9-13, 15-20, 56-62, 64-65, 67, 69-73, 75-80, 116-122, 127, 129, 131-135, 137-142, and 178-184 incorporate the elements discussed above with respect to claim 4 (as well as other novel elements), and therefore, *Tsuei* fails to disclose every element of these dependent claims. Applicants respectfully submit that the Final Office failed to establish the necessary showings under 35 U.S.C. § 102(e), and that the Examiner's 35 U.S.C. § 102(e) rejections of the claims include clear errors in reading and applying the cited art.

II. Conclusion

Because the Examiner's 35 U.S.C. § 102(e) rejections of the claims include clear errors, and because the Final Office Action failed to establish that *Tsuei* discloses each and every elements of Applicants' claims, as demonstrated herein and in the previously filed responses, Applicants are entitled to reversal of the rejections in the Final Office Action.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 4, 2009

By: 

Judy W. Chung
Reg. No. 61,612